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EXAMINER

FULLER, ERIC B

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/828,175

Applicant(s)

LAZZERINI, MAURIZIO

Examiner

Eric B Fuller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to add the limitation that the polyester backing-layer is separated from the covering layer after the preset regions have been removed. The specification lacks support for this limitation. In the response filed concurrently with the amendment, the applicant alleges that support is found in originally filed claim 7. However, this is not so. The original claim 7 reads, "wherein said backing layer is constituted by a band or tape which can be separated in order to obtain threads". This does not teach that the backing-layer is separated from the covering layer nor that it is performed after said preset regions have been removed. Claim 7 reads that the backing-layer may be a band threads that can be separated into individual threads. Accordingly, the amendment introduces new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claim 7 to read, "said backing layer is constituted by a band to obtain threads". This is confusing.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harbaugh (US 5,535,871) in view of Hutton (US 5,959,768) in further view of Franklin et al. (US 4,184,701).

Harbaugh teaches a security thread for currency that is made of a plastic thread, such as polyester (column 7, lines 50-57), coated with a metallic layer, such as aluminum (column 7, line 60). The reference further teaches to use laser etching to remove preset areas in order to produce visible alphanumeric characters and/or machine detectible codes (column 8, line 1; column 7, lines 15-50). The reference is silent to how laser etching is used to remove the preset regions.

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However, Hutton teaches a process of etching aluminum from a clear, plastic substrate (column 4, lines 60-65; column 5, lines 5-15). This is performed using a Nd:YAG laser with a wavelength between 850 nm to 2 microns (column 4, line 67; column 6, lines 33-35). From figure 6, it is shown that the laser passes through the plastic substrate before reaching the aluminum coating. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize the etching process taught by Hutton to perform the laser etching taught by Harbaugh. By doing so, one would have a reasonable expectation for success.

The combined references fail to teach removing the backing layer from the covering layer after the preset regions are removed. However, Franklin teaches to make the backing layer such that it separates from the covering layer when removed (abstract). This is done in order to make the code tamper resistant. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the layers separable in order to prevent tampering. It is the position of the examiner that since it is taught that the layers are made to be separable, this reads on separating the layers.

Harbaugh teaches the limitations to claims 7 and 8 in figures 3, 4, and 6.

As to claim 12, Harbaugh teaches that the security thread is embedded into the paper (column 8, line 8). To do this before or after the laser-etching step would have been obvious to those skilled in the art with the reasonable expectation of achieving similar results.

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Claims 1, 2, 7, 8, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harbaugh (US 5,535,871) in view of Zientek (US 6,372,394 B1) in further view of Franklin et al. (US 4,184,701)..

The teachings of Harbaugh have been discussed above. Along with how the laser-etching process is performed, Harbaugh also fails to teach using ink as the coating layer.

However, Zientek teaches a method of laser etching an ink coating off of a polymeric substrate (abstract). This is used in order to produce markings for security documents. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use ink as the coating in Harbaugh for producing the alphanumeric codes that need only to be detectable visually. By doing so, a less expensive material is being used as the coating, thus resulting in a less expensive process.

Additionally, Zientek teaches that the wavelength of the laser is between .5 microns to about 20 microns, which is inclusive of the applicant's range. It is also taught that the laser may be used to etch off ink from one side of the substrate, or both sides simultaneously (column 2, lines 50-60; figures 1 and 2). It would have been obvious to one skilled in the art that to have the laser directly hit the ink or to have the laser go through the substrate first would result in similar process. To use either method would have obvious.

The combined references fail to teach removing the backing layer from the covering layer after the preset regions are removed. However, Franklin teaches to

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make the backing layer such that it separates from the covering layer when removed (abstract). This is done in order to make the code tamper resistant. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the layers separable in order to prevent tampering. It is the position of the examiner that since it is taught that the layers are made to be separable, this reads on separating the layers.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harbaugh (US 5,535,871) in view of Zientek (US 6,372,394 B1) and Franklin et al. (US 4,184,701), as applied to claim 1 above, and further in view of Hutton (US 5,959,768).

Harbaugh, Zientek, and Franklin are used for their combined teaching of claim 1. However, both references fail to teach what type of laser should be used to perform the etching. However, Hutton teaches that Nd:YAG lasers are used for etching because glass and plastic substrates are transparent to the 1.06 um wavelength (column 6, lines 35-40). Therefore it would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a Nd:YAG laser in the process taught by Harbaugh, Zienteck, and Franklin. By doing so that substrate is transparent to the laser, as is desired by Zeinteck in column 2, line 67).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harbaugh (US 5,535,871) in view of Hutton (US 5,959,768) and Franklin et al. (US 4,184,701), as

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applied to claim 1 above, and further in view of Mantegazza (EP 0 310 707 A2) and Meyer et al. (US 5,858,474).

Harbaugh, Hutton, and Franklin are used for their combined teaching of claim 1. However, both references fail to teach that the coating layer is a magnetic layer. However, Mantegazza teaches that security threads made of polyester, with magnetic iron oxide codes inscribed, may be used in anti-forgery documents. The advantage of using the magnetic layer is that it is not optically detectable, thus making it difficult to reproduce by forgery (column 1, lines 49-52). Additionally, Meyer, as shown in previous office actions, shows that magnetic coatings are capable of being etched by laser. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to use magnetic coatings, such as that taught by Mantegazza, for producing the machine detectable codes taught in the process of Harbaugh, Hutton, and Franklin. By doing so, the code is not optically detectable and forgery is deterred.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harbaugh (US 5,535,871) in view of Hutton (US 5,959,768) and Franklin et al. (US 4,184,701), or Harbaugh (US 5,535,871) in view of Zientek (US 6,372,394 B1) and Franklin et al. (US 4,184,701), as applied to claim 1 above, and further in view of Leenders (US 5,478,695).

None of the references up this point teach that the coating may further be coated with a second backing layer. However, Leenders teaches an optional covering layer to



be applied to a metal coating that is to be laser etched off of a resin substrate. This covering layer is to protect the metal from mechanical wear (column 5, lines 1-5). This covering layer reads on a second backing layer applied to the other face of the coating layer. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize the covering layer of Leenders in the process taught by Harbaugh, Hutton, and Franklin or Harbaugh, Zienteck, and Franklin. By doing so, mechanical wear is prevented.

### ***Response to Arguments***

Applicant argues that the prior art made of record fails to teach the added limitation of claim 1. Applicant's arguments have been considered are moot in view of the new grounds of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shulman (US 4,428,997), Smits et al. (US 5,149,386), and McGinness et al. (US 5,605,738) are all cited for teaching removable backing layers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck, can be reached at (703) 308-2333. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



EBF

March 25, 2003



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